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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,268	01/29/2002	Warren Keith Edwards	PARC-DA1085	2691
22835 7590 03/20/2007 PARK, VAUGHAN & FLEMING LLP 2820 FIFTH STREET DAVIS, CA 95618-7759			EXAMINER CHANKONG, DOHM	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/058,268

Applicant(s)

EDWARDS ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1> This action is in response to Applicant's request for continued examination, filed 2.26.2007. Claims 1, 8, 12, 19, 23 and 30 are amended. Claims 1-33 are presented for further examination.

2> This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2.26.2007 has been entered.

Response to Arguments

4> Applicant asserts that the present invention teaches a data object and a data transfer session object. Applicants claim only are cite a data transfer session object. Nothing in the claims discloses a data object or the functionality discussed related to the data object. In discussing the data object, Applicant is arguing limitations not present in the claims. It is noted that Reed discloses a single communications object that is responsible for the communications between components. Applicant is encouraged to amend the claims to

include the limitations with respect to the data object as the current claims only describe a single data object that is responsible for communications between components.

5> Applicant's amended claim language presents several confusing issues that result in a §112 rejection. First, Applicant argues that nothing in the references "teaches *sending a DTSO to an intermediary device* to facilitate communication between two devices" (emphasis added). Applicant's arguments, pg. 15, ¶1. Applicant's amended language states that "the second component can be an intermediary component which facilitates *transferring of the DTSO from the first component to the at least one of the plurality of components*" (emphasis added). Thus, contrary to the functionality described in Applicant's argument, Applicant's claim is directed towards an intermediary that acts to transfer the object from one component to another. Thus, the amended language and Applicant's arguments are inconsistent.

Second, the inconsistency carries into the claim language which renders the claims confusing and difficult to correlate with Applicant's specification. The independent claims contain limitations that describe different embodiments of Applicant's claimed invention. The amended language describes how the second component facilitates the transfer of the DTSO between components. Applicant cites an example in Figure 7 of the specification. Using the parlance of the claims, the computer 20 is the second component, the server 23 is one of the plurality of components and the printer 21 is the first component.

According to that example, the second component (computer) is responsible for invoking the interfaces for the components (printer, server), negotiating between the components (printer and server) and transferring data between the first component and the

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at least one of the plurality of components [0053]. But then other limitations within the same claim ignore the second component completely and state that the first component and the at least one of the plurality of components negotiate directly with each other to select a transfer medium and transfer data. Another limitation discloses that the at least one of the plurality of components invokes the DTSO which is inconsistent with the example of Figure 7. That example expressly discloses that the intermediary component (computer 20) invokes the DTSO to facilitate communications between the components [0053]. Some limitations of the claims are directed towards examples embodied in Figures 3 and 5 while other limitations in the claim are directed towards the embodiment of Figure 7. There is therefore a §112 issue with respect to the new amended language.

Third, the amendment states that the second component “can” be an intermediary component. The use of the term “can” is not suggested as it describes what the component is capable of doing and not what it is. Applicant is reminded that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. MPEP §2114.

6> Additionally, contrary to Applicant’s assertions, Reed discloses the amended language. Reed discloses a web server that is an intermediary component which facilitates transferring of the DTSO from the first component (provider computer) to a second component (consumer computer) [Figure 1 | column 26 «lines 52-67»]. The web server serves to facilitate communication between the components [column 12 «line 63» to column 13 «line 10» : “consumer computer 2... initiates a transfer of information directly from a provider

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computer 1 or from another server computer 32"]. Thus, Applicant's amendment does not overcome the Reed reference. Applicants claims, as they are currently written, do not patentably distinguish over the prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7> Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. As discussed in detail in the response, the independent claims contain limitations directed at different embodiments of Applicant's invention. The amended language and Applicant's remarks point to the example found in Figure 7 where there are three clear components [see Applicant's claim 8]. This embodiment discloses that the second component negotiates between the components, invokes the DTSSO and generally negotiates data transfer between the components. There are limitations in the claim that are inconsistent with this interpretation and point instead to examples found in Applicant's Figures 3 and 5.

b. The dependent claims are rejected as a result of their dependency on the independent claims.

c. All independent claims are rejected for claiming that the second component "can" be an intermediary component. This phrasing does not clearly claim the

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features of the second component. The Office will interpret the language as reciting that the second component "is" an intermediary component that facilitates transferring of the DTSO as typified in Figure 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8> Only those claims that have been amended by Applicant are formally addressed in this action. The rejection of those claims not specifically addressed in this §103 rejection can be found in prior Office actions, filed 1.4.2007 and 8.22.2006.

9> Claims 1-33 are rejected under 35 U.S.C § 103(a) as being unpatentable over Reed et al, U.S Patent No. 6,345,288 ["Reed"], in view of Bischoff et al, U.S Patent No. 6,718,377 ["Bischoff"].

10> As to claim 1, Reed discloses a system for enabling components to transfer data between each other, the system comprising:

a plurality of components including a first component having a universal data transfer interface [Figure 1 | column 7 «line 59» to column 8 «line 3»];

a second component capable of invoking the universal data transfer interface to cause a data transfer session object (DTSO) to be sent to at least one of the plurality of components when the at least one of the plurality of components has data to transfer to another component from the plurality of components, wherein the second component can be an intermediary component, which facilitates transferring of the DTSO from the first component to the at least one of the plurality of components [column 12 «line 63» to column 13 «line 3» | column 14 «lines 43-53» | column 86 «lines 64-66» : transferring of the message object with the communications object and Reed's web server corresponds to the second component. The web server facilitates transferring of the DTSO from the first component (provider computer) to the at least one of the plurality of components (consumer computer)];

wherein the DTSO is capable of being invoked by the at least one of the plurality of components to transfer data between the first component and the at least one of the plurality of components [column 8 «lines 6-19» | column 17 «lines 25-28» | column 70 «lines 51-67» where : Reed's communications object is analogous to Applicant's claimed DTSO];

wherein the DTSO includes instructions that enable the first component to receive asynchronous event notifications [column 14 «lines 24-56» : "notification of the provider" | column 56 «lines 15-52»];

wherein the DTSO includes instructions to return device type and operating status of the first component [column 49 «lines 21-50»]; and

wherein the DTSO includes instructions to enable the first component or the at least one of the plurality of components to negotiate with each other to select a transfer medium to

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use to transfer data based upon the type of data [column 12 «lines 44-50» | column 53 «line 54» to column 54 «line 49»].

Reed does disclose that the second component (provider computer) is aware of the data type supported by the first component (consumer) [column 14 «lines 21-59»] and also the first component can provide means, such as special forms, for the second component to return specific types of data [column 14 «lines 26-32»]. Reed however does not expressly disclose instructions to return data types supported by the first component.

11> In the same field of invention, Bischoff is directed towards a system with a provider and consumer computer (analogous to claimed second and first component, respectively) [abstract]. Like Reed, the provider and consumer are enabled to communicate with one another using a standardized interface comprised of various communication objects located at the computers [column 2 «lines 14-30 and 65-67»]. To achieve this functionality, Bischoff discloses returning data types from the consumer computer that are supported by the consumer computer to the provider computer to enable communications between the consumer and provider computer [Figure 4 | column 2 «lines 20-30» | column 7 «lines 56-67»].

It would have been obvious to one of ordinary skill in the art to modify Reed with Bischoff's teachings. One would have been motivated to provide such a combination to provide a means for Reed to obtain the supported data formats and types of a consumer computer as represented by Bischoff's feature.

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12> As to claims 8, 12, 19, 23 and 30, see rejection of claim 1 above, and previous rejections as set forth in the previous Office action, filed 8.22.2006.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kronz, U.S Patent No. 6.675.196;

Abu-Samaha, U.S Patent No. 6.938.087.

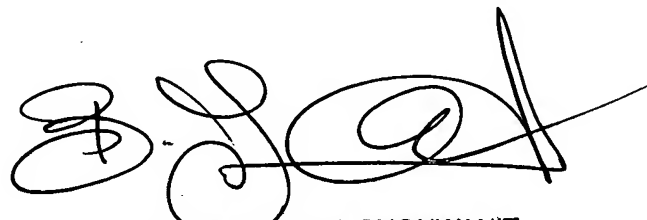
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DC



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